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10/570,029

03/01/2006

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EXAMINER

DIAZ, THOMAS C

ART UNIT

PAPER NUMBER

3656

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|-------------------------------|--|--|
| Office Action Summary | Application No. 10/570,029 | Applicant(s) ROUSSIN-BOUCHARD, XAVIER | |
| | Examiner THOMAS DIAZ | Art Unit 3656 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/01/2005</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 2 recites the limitation "the overmolded layer of synthetic material" in claim 2. There is insufficient antecedent basis for this limitation in the claim. It is unclear whether this is referring to the "jacket" from claim 1 or some other layer.

Specification

The disclosure is objected to because of the following informalities: The specification should include headings for the appropriate sections as described in CFR 37 § 1.77.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3656

5. Claims 1,3,4, 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Kikuchi et al. (USP 5501120).

Regarding claim 1, Kikiuchi et al. discloses a control handle (see fig.1), comprising a core (fig.1, 2) which delimits an interior cavity (fig.1, 2b,2c), on which are mounted control elements comprising buttons and/or sliders (col.3, lines 41-44), characterized in that at least part of the surface of the core is covered with a jacket (fig.1, 3) consisting of a layer of at least one thermosetting polymer foam (col.3, lines 63-65).

Regarding claim 3, Kikiuchi et al. discloses that the jacket is overmolded in one piece on to the core (col.4, lines 26-30).

Regarding claim 4, Kikiuchi et al. discloses that the core is made of a reinforced thermoplastic material (col.1, lines 58-59; Note that hard resin reads on thermoplastic material).

Regarding claim 6, Kikiuchi et al. discloses that the overmolded jacket comprises at least one solid protruding part (see fig.2, Part of 3 that forms 2b).

Regarding claim 7, Kikiuchi et al. discloses that at least one solid protruding part comprises at least one cavity (see fig.2, the cavity 2b is formed on the protruding part).

Regarding claim 8, the claim recites product by process limitations and will not be given patentable weight. Please see MPEP 2113.

Claim Rejections - 35 USC § 103

Art Unit: 3656

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kikuchi et al. (USP 5501120).

Regarding claim 3, Kikuchi et al. is silent to the thickness of the jacket being at least 4 mm.

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to optimize the thickness of the jacket depending on the important variables such as weight, comfort, or hardness related to the jacket; since it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kikuchi et al. (USP 5501120) in view of Huang (USP 5571050).

Regarding claim 2, Kikuchi et al. fails to disclose that the overmolded layer of synthetic material is made from polyurethane. (Assuming the jacket is the layer.)

Huang teaches the use of an overmolded layer of synthetic material made from polyurethane to form a grip on a golf club (see fig. 20, PU) for the purpose of providing a cushioned grip and enhance tackiness to the user (see col.1, lines 34-36).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use an overmolded layer of synthetic material made from

Art Unit: 3656

polyurethane, as taught by Huang, in the control lever disclosed by Kikuchi et al. for the purpose of providing a cushioned grip and enhance tackiness to the user.

9. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kikuchi et al. (USP 5501120) in view of Hollander (USP 4937429).

Regarding claim 9, Kikuchi et al. fails to disclose that a heating cable is positioned around the core.

Hollander teaches a heating cable (fig.2, 26) positioned around a core (fig.1, 12) of a handle for the purpose of providing a heated hand grip which is useful, for example, when the handles are used in cold weather environments (col.1, lines 6-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the control lever disclosed by Kikuchi et al. to include a heating cable (fig.2, 26) positioned around the core, as taught by Hollander, for the purpose of providing a heated hand grip which is useful, for example, when the handles are used in cold weather environments (col.1, lines 6-15).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS DIAZ whose telephone number is (571)270-5461. The examiner can normally be reached on Monday-Friday 8:30am to 5:30pm, First Friday's off..

Art Unit: 3656

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on (571)272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Thomas Diaz/
Examiner, Art Unit 3656

/Richard WL Ridley/
Supervisory Patent Examiner, Art Unit 3656